

10/689,789

the finality of the rejection is therefore premature. In particular, applicants note that the present prosecution record is deficient for at least the following reasons.

- 1) The rejections in the prior office action were unclear, but the office action simply incorporates them by reference without clarifying the rejections. The Examiner has somewhat clarified the Examiner's position in numbered paragraph 5 of the final office action, but numbered paragraph 5 does not form any part of the rejections of record. If the Examiner is relying on any portion of numbered paragraph 5 to sustain the rejections, applicants respectfully request that the rejections be re-stated with the Examiner's formal position. In order to have a clear record for appeal, applicants are entitled to a new office action which sets forth the Examiner's formal position. Alternatively, applicants respectfully request that any subsequent communication from the Examiner positively states that the Examiner is relying solely on the rejections as set forth in the office action mailed August 11, 2004.
- 2) The office action repeats the rejection of claims 11-20 under 35 U.S.C. § 103(a) without considering the amendment made to claim 12. In the prior action, the rejection was made under § 103 because of some claim language that has been canceled from claim 12. Accordingly, it appears that the rejection, if maintained, should be made under § 102. In any event, the Examiner's position is unclear. In order to have a clear record for appeal, applicants are entitled to a new office action which sets forth the correct rejection, along with the Examiner's formal position. Alternatively, applicants respectfully request that any subsequent communication from the Examiner positively states that the Examiner is relying solely on the rejections as set forth in the office action mailed August 11, 2004.
- 3) The Examiner is required to answer all traversals. MPEP § 707.07(f) provides that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of

10/689,789

it." Accordingly, the Examiner should have responded to the substance of all of applicants' prior arguments. In particular, the Examiner failed to respond the substance of applicants' arguments regarding:

- a) there is no supporting description of Fig. 6 or elsewhere in Chen which describes the walls 34 contacting the card 102;
- b) that the card 102 does not protrude sufficiently beyond the walls 34 to even involve lateral flexing of the card 102;
- c) that in the more detailed Figs. 7A-7D and 10A, it is clear that the walls 34 provide clearance for the card 102, but do not contact the side surfaces of the card 102;
- d) that Figs. 7A-7D are the more detailed views of Fig. 6; and
- e) that Figs. 7A-7D and 10A show substantial clearance between the walls 34 and the card 102.

In order to have a clear record for appeal, applicants are entitled to a new office action which sets forth the Examiner's formal position for each of the above arguments.

4) MPEP § 2141.02 sets forth that "[p]rior art must be considered in its entirety, including disclosures that teach away from the claims." Applicants submit that Figs. 7A through 7D of Chen teach away from the claims, particularly any claim which recites that the guide contacts the card. The office action does not set forth how the Examiner has considered this disclosure, if at all. Accordingly, the prosecution record is not clear. In order to have a clear record for appeal, applicants are entitled to a new office action which sets forth the Examiner's formal consideration of Chen's disclosure which teaches away from the claims.

5) It now appears that the office action is relying on a theory of inherency. However, the prosecution record is unclear because the reliance on inherency is not stated in any rejection. The office action does not, despite applicants prior request for clarification, point out any express disclosure that the walls 34 in Chen inhibit any lateral movement of the card 102 in Chen (the newly cited 'closed type space' in col. 1, lines 18-

10/689,789

23 still lacks such express disclosure). Accordingly, applicants are left to presume that the Examiner is relying on some unstated theory of inherency. Applicants remind the Examiner that MPEP § 2112 states that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” Moreover, MPEP § 2112 further states that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” The office action does not meet the burdens set forth in MPEP § 2112 to establish inherency.

In view of the foregoing, applicants respectfully request a **new non-final action** to make a complete and clear prosecution record for possible appeal. MPEP § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” Because the office action does not clearly set forth the Examiner’s position with respect to numbered paragraphs 1 through 5 above, the applicants have been deprived of a fair opportunity to provide evidence or reply completely. Moreover, MPEP § 706.07 states that “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant.” Given all of the above-identified ambiguities in the office action, no clear issue has yet developed between the examiner and the applicant, and many unclear issues remain outstanding.

Regarding the substance of the rejection, applicants have little choice but to repeat the previous arguments and hope that the Examiner will answer the substance of these arguments.

Claim 1 recites, among other things that the guide is adapted to inhibit lateral movement of the card. Claim 12 recites, among other things, inhibiting lateral movement of the card with the guide. Chen fails to teach or suggest this feature.

10/689,789

The office action cites the walls 34 of the housing for allegedly corresponding to the recited guide, but only generally asserts, without citation to any supporting portion of Chen, that Chen discloses that the walls 34 are adapted to inhibit lateral movement of the card (102). However, this unsupported assertion is incorrect.

The walls 34 collectively form the housing 32 of the connector 100. But the walls 34 do not inhibit lateral movement of the card 102. Applicants first note that the office action fails to identify any portion of Chen which describes the walls 34 inhibiting lateral movement of the card 102. It appears that the Examiner is relying solely on the illustration in Fig. 6 to sustain the rejection. In order to clarify issues for appeal, if the rejection is maintained, applicants respectfully request that in the next communication from the Examiner, the Examiner:

- A) Admit that no text portion of Chen describes the recited inhibiting lateral movement of the card with the guide; OR
- B) Point out with particularity where the text of Chen provides such description.

In any event, applicants can find no supporting text in Chen describing any portion of the walls 34 inhibiting lateral movement of the card 102. With reference to Figs. 7A through 7D, and Fig. 10A of Chen, it appears that the slots in the walls 34 provide a clearance for a short portion of the card 102 to protrude therethrough, but the walls 34 do not even contact the card 102. Therefore, the walls 34 do not inhibit lateral movement of the card 102. Accordingly, neither the text description nor the drawings of Chen teach or suggest a guide adapted to inhibit lateral movement of the card, or as recited in claim 12, inhibiting lateral movement of the card with the guide. In order to clarify issues for appeal, if the rejection is maintained, applicants respectfully request that in the next communication from the Examiner, the Examiner:

- A) Admit that as illustrated in Figs. 7A through 7D the walls 34 including the slot formed in the walls provide a clearance for the card 102; OR

10/689,789

B) Identify with particularity (e.g. an annotation on the drawings) where Figs. 7A-7D contacts the card 102.

In numbered paragraph 5 of the final office action, the Examiner argues essentially that the perspective view of Fig. 6 of applicants has some similarity to Chen's Fig. 6, and therefore Chen shows that the walls 34 are adapted to inhibit lateral movement of the card 102. This is simply erroneous. The perspective view in both applicant's specification and Chen are limited in their ability to communicate the more detailed description of their respective structures. This is of course why patent specifications include textual description of the figures and more detailed drawings views. It is the textual description of applicants' disclosure that describes how the guide 44 inhibits lateral movement of the card 63. For example, paragraph 35 of applicants' specification describes that 'the walls 44a and 44b of the guide 44 may contact one or more side surfaces of the card 63 to reduce the amount the card 63 may flex about the pivot point near the end of the connector 42.' In contrast, Chen provides no such description in connection with the walls 34 or the slot 24. Moreover, the more detailed views of Figs. 7A-7D contradict the Examiner's position. The description of the drawings, at col. 2, lines 47 – 62 of Chen, makes it clear that Figs. 7A-7D are the more detailed description of Fig. 6.

Because Chen fails to teach or suggest a guide is adapted to inhibit lateral movement of the card, claim 1 is not anticipated by and is patentable over Chen. Claims 2-11 depend from claim 1 and are likewise patentable.

Because Chen fails to teach or suggest inhibiting lateral movement of the card with the guide, claim 12 is patentable over Chen. Claims 13-20 depend from claim 12 and are likewise patentable.

10/689,789

With respect to claims 2 and 13, Chen does not teach or suggest that the walls 34 provide a side constraint for the card 102. Moreover, the card 102 does not protrude sufficiently beyond the walls 34 to even involve lateral flexing of the card 102. Applicants note that Chen is not concerned with and does not even mention lateral flexing of the card 102. In order to clarify issues for appeal, if the rejection is maintained, applicants respectfully request that in the next communication from the Examiner, the Examiner:

- A) Admit that the card 102 in Chen does not protrude sufficiently beyond the walls to involve lateral flexing of the card 102; OR
- B) Identify with particularity where such lateral flexing is discussed and explain how the unpopulated short sections of the card 102 might cause problems with lateral flexing.

With respect to claims 3 and 14, the walls 34 do not contact the card 102. Applicants note that the relied upon Fig. 6 is a perspective view which does not provide sufficient detail to determine whether or not the walls 34 contact the card 102. However, there is no supporting description of Fig. 6 or elsewhere in Chen which describes the walls 34 contacting the card 102. Upon review of the more detailed Figs. 7A-7D and 10A, it is clear that the walls 34 provide clearance for the card 102, but do not contact the side surfaces of the card 102. In fact, the text description of Chen makes clear that Figs. 7A-7D are the more detailed views of Fig. 6. The Examiner must also consider those portions of Chen which teach away from the claims. In order to clarify issues for appeal, if the rejection is maintained, applicants respectfully request that in the next communication from the Examiner, the Examiner:

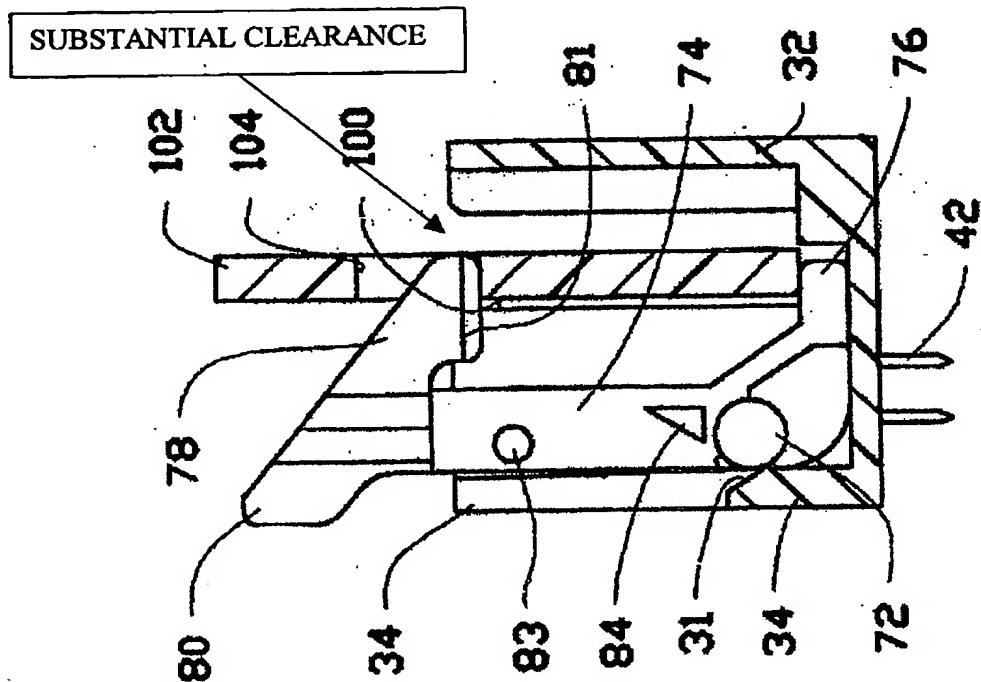
- A) Admit that Figs. 7A-7D are the more detailed views of Fig. 6; OR
- B) Explain the Examiner's position with respect to Figs. 7A-7D.

With respect to claims 4 and 15, applicants note that Figs. 7A-7D and 10A show substantial clearance between the walls 34 and the card 102. Accordingly, the walls 34

10/689,789

do not contact two opposed side surfaces of the card 102. In order to clarify issues for appeal, if the rejection is maintained, applicants respectfully request that in the next communication from the Examiner, the Examiner:

A) Admit that Fig. 7A, as annotated below, shows substantial clearance between the walls 34 and the card 102; OR



B) Explain the Examiner's position with respect to how Figs. 7A-7D show the walls 34 contacting both sides of the card 102.

10/689,789

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

s/Paul E. Steiner/
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